PATENT

Customer No. 23990

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : Bryan J. Moles, et al.

Serial No. : 09/542,632

Filed : April 4, 2000

For : SYSTEM AND METHOD FOR PROVISIONING OR UPDATING A MOBILE STATION USING OVER-THE-AIR TRANSFER OF INTERPRETED BYTE-CODE PROGRAM

Art Unit : 2618

Examiner : Eugene Yun

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Commissioner for Patents
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Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal. The review is requested for the reason(s) stated in the arguments below, demonstrating the clear legal and factual deficiency of the rejections of some or all claims.

Claims 1, 2, 5-7, 10-12, 16, 16, and 20 were rejected as obvious over U.S. Patent No.6,587,684 to *HSU, et al.* (hereafter, "Hsu") and U.S. Patent No. 6,421,727 to *REIFER, et al.*

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(hereafter, "Reifer") and further in view of U. S. Patent No. 6,243,572 to *CHOW, et al.* (hereafter,

"Chow"). Claims 3, 4, 8, 9, 13-15, 18, and 19 were rejected as obvious over Hsu and Chow and

further in view of U. S. Patent No. 6,314,282 to *WEBER et al.* (hereafter, "Weber"). For the

convenience of the panel, claim 1 is reproduced below:

> 1. (Previously Presented) For use in a wireless network comprising a plurality of base stations, each of said base stations capable of communicating with a plurality of mobile stations, a service provisioning system capable of provisioning a first one of said plurality of mobile stations comprising:
>
> a database capable of storing a service provisioning file comprising a mobile station service provisioning program in interpreted byte-code format; and
>
> a provisioning controller coupled to said database capable of receiving a notification indicating that said first mobile station is unprovisioned and further capable, in response to receipt of said notification, of retrieving said service provisioning file from said database and transmitting said service provisioning file to said first mobile station, wherein receipt of said service provisioning file causes said first mobile station to automatically execute said mobile station service provisioning program in said service provisioning file, execution of said mobile station service provisioning program automatically provisioning said first mobile station without further interaction from a service operator.

Reifer is a satellite-based communications system that uses a browser system for service

provisioning. The Examiner relies on col. 9, lines 7-15 for the claimed "a database capable of

storing a service provisioning file comprising a mobile station service provisioning program in

interpreted byte-code format":

> FIG. 9 is a diagram which illustrates the SPNet system of the present invention. In accordance with the present teachings, a browser at the Service Provider's location is used to download a JAVA application which, when executed, provides for service provisioning including service activation, suspension, reactivation and deactivation for

telephone, paging, roaming and other services from a database at the GBS.

It is clear that neither this passage, nor any other passage in Reifer (or any other art of record, alone or in combination), teaches or suggests a database, coupled to a provisioning controller, capable of storing a service provisioning file comprising a mobile station service provisioning program in interpreted byte-code format, where the database must meet the other limitations of claim 1.

Examiner Yu argues that either the claimed provisioning controller can be either the "SPNet Server" of Fig. 9, or the entire "SPNet system" of Fig. 9, including a browser, the entire Internet, the SPNet server, the GBS database, and the mysterious "QA KV", which is not described at all by Reifer. To the extent that Examiner Yu intends to equate the SPNet Server with the claimed provisioning controller, it is clear that the limitations of claim 1 are not met. Nothing in Reifer teaches or suggests that the SPNET Server is capable of receiving a notification indicating that a first mobile station is unprovisioned. Examiner Yu responds baselessly that "the SPNet server can indeed be a provisioning controller simply because the SPNet server is majorly involved in service provisioning". Perhaps the SPNet server is a provisioning controller – but it is not a provisioning controller according to the requirements of the independent claims, and so the rejection is legally and factually deficient.

Further, it is clear that even if Hsu's database 28 (alleged by the Examiner to correspond to the claimed database) were modified according to Reifer to include a "JAVA application which, when executed, provides for service provisioning including service activation, suspension, reactivation and deactivation for telephone, paging, roaming and other services", it would not be

operable in Hsu's system. Nothing in Hsu, Chow, or Weber teach or suggest that the mobile station is even capable of executing a JAVA application, and so Reifer's application cannot, in fact, be executed in the proposed system of Hsu, Chow, and Weber.

Examiner Yu responds by stating essentially that Hsu, Chow, and Weber could be modified by "the addition of JAVA enabled software". There is no teaching or suggestion in any of these references that this could be done, and there is certainly no motivated teaching or suggestion that it should be done. This is a legally and factually deficient rejection.

Claim 1 also requires that receipt of the service provisioning file causes said first mobile station to automatically execute the mobile station service provisioning program. Nothing in the art of record teaches this feature. In the Advisory Action, Examiner Yu now states that this is supported in Chow col. 13, line 64 – col. 14, line 1:

> The feature code and/or PIN in combination will be given to the new subscriber so they may actuate their LCS service automatically via a self-activating and authenticating process to be referred to herein as over-the-air activation teleservice (OATS).

Nothing in this passage teaches or suggests that receipt of a service provisioning file causes a first mobile station to automatically execute a mobile station service provisioning program. No art of record teaches or suggests the limitation of "wherein receipt of said service provisioning file causes said first mobile station to automatically execute said mobile station service provisioning program in said service provisioning file, execution of said mobile station service provisioning program automatically provisioning said first mobile station without further interaction from a service operator" as required by claim 1.

There are numerous other distinctions over the multiple-reference combinations proposed by Examiner Yu, as detailed in previous responses. In the Advisory Action, Examiner Yu states without any support at all that "it is believed by the Examiner ... that the majority of newly purchased mobile phones known the art send a notification to a provisioning controller that it is unprovisioned as soon as it is activated for the first time" and that other limitations are "believed by the examiner to be obvious...." As Examiner Yu is now relying on his completely unsupported personal beliefs, the legal and factual deficiency of the rejections clear.
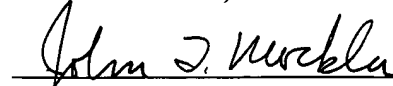
CONCLUSION

As a result of the foregoing, the Applicant asserts that the claims in the Application are in condition for allowance over all art of record, and that the rejections are both factually and legally deficient, and respectfully requests this case be returned to the Examiner for allowance or, alternatively, further examination.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Munck Butrus Deposit Account No. 50-0208.

Respectfully submitted,

MUNCK BUTRUS, P.C.

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